

REMARKS

The following issues are outstanding in the pending application:

- Claims 7 and 9 are rejected under 35 USC 102;
- Claim 11 is rejected under 35 USC 103; and
- Claim 10 is rejected under 35 USC 103.

35 USC 102

Claims 7 and 9 are rejected under 35 USC 102(e) as being anticipated by U.S. Pat. No. 6,957,915 to Tankersley. Applicant respectfully traverses this rejection.

Tankersley is directed to a standup bag manufactured from an extruded, heat sealable film in order to combine the cost advantages of using low cost extruded polyethylene film with the manufacturing advantages of using high temperature jaws in a continuous laminated film line. The extruded film has an inside sealing layer which can be sealed at a lower temperature than the outer/exterior support layers. The differential in the heat sealing temperature of the entire inside sealing layer and the entire outer support layers allows for use of continuous heat sealing clamps, jaws or similar heat sealing devices that do not require a cooling medium for the film (Col. 3, lines 1-7). The method for producing the standup bag includes the steps of wrapping a single piece of heat sealable film around a tube to continuously form the front wall, the two side walls, and the rear wall; and heat sealing, without using a cooling medium for controlling temperature of the film, the first and second side edges to each other to close the rear wall; and folding the two side walls inwardly between the front and rear walls so as to form gussets in the top portion and the bottom portion. The bottom edge is heat sealed to seal the bottom portion, the bag is filled and the top edge is sealed to seal the top portion. A perforation is inserted in the top portion for opening the bag and to form a spout for pouring out the material in the bag when the bag is opened (Col 3, lines 40-60). The heat sealable film 30 is manufactured with an inside sealing layer that has a lower seal initiation temperature than the entire outer support layer. Heat must be applied to the outer layer 36 at a temperature higher than the melting point of the inside sealing layer 35. The heat must be applied at or above the melting point of the outer

layer 36 to seal ear sections 38, 39, but below the temperature at which the outer layer 36 is destroyed (Col 5, lines 37-46).

To anticipate a claim, the reference must teach *every element* of the claim (MPEP 2131). Further, it is well established case law that “[a] claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference” and “[t]he identical invention must be shown in as complete detail as contained in the ... claim.” See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cri. 1987); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); and MPEP 2131.

Tankersley at least does not teach a package comprising “first and second regions of sealing *between sheets* of the compostable material in which the material of the second sealable layer has a lower heat-sealing initiation temperature than the material of the first sealable layer, and wherein said first region has a relatively high sealing strength, and said second region has a relatively low sealing strength” (Claim 7). The sheets as defined by the claims comprise a substrate layer and two sealable layers. The Examiner has cited within Tankersley the first region of sealing as being the inside layer bonded to the outside layer, and the second region of sealing as being the outside layer being bonded to the exterior layer (Action, page 2-3). However, the claims have clearly recited that the regions of sealing are between compostable *sheets* rather than between *layers* as the Examiner has presented. As such, Tankersley does not teach each and every element of the claims and, thus, does not anticipate the claims. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 7 and 9 under 35 USC 102(e) as being anticipated by U.S. Pat. No. 6,957,915 to Tankersley.

35 USC 103

Claim 11 is rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Patent No. 6,957,915 to Tankersley. Applicant respectfully traverses this rejection.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual

inquires enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with claim 11 that requires a method of manufacturing the package that includes at least the steps of providing a compostable sheet material having compostable substrate layer with a first compostable and sealable layer on an inner first side of the substrate layer, and a second compostable and sealable layer overlying the first sealable layer on the inner side of the substrate layer in which the material of the second sealable layer has a lower heat-sealing initiation temperature than the material of the first sealable layer. The step of sealing is carried out under a first set of conditions in a first region of the margin and under a second set of conditions different from the first set of conditions in a second region of the margin hereby the peel strength of the resulting seal is different in the first and second regions.

The Tankersley reference does not teach a method of manufacturing the package that includes at least the steps of providing a compostable sheet material comprising a compostable substrate layer, a first compostable and sealable layer on an inner first side of

the substrate layer, and a second compostable and sealable layer overlying said first sealable layer on the inner side of the substrate layer in which the material of the second sealable layer has a lower heat-sealing initiation temperature than the material of the first sealable layer. The step of sealing is carried out under a first set of conditions in a first region of the margin and under a second set of conditions different from the first set of conditions in a second region of the margin hereby the peel strength of the resulting seal is different in the first and second regions. As discussed above, Tankersley teaches a method of forming a package with a film having an inside sealing layer that has a lower seal initiation temperature than the outer support layer. There is also no teaching in Tankersley of a sealing step that is carried out under a first set of conditions in a first region of the margin and under a second set of conditions different from the first set of conditions in a second region of the margin hereby the peel strength of the resulting seal is different in the first and second regions.

The Examiner has merely stated that "... because Tankersley discloses heat sealing of a package, it would have been obvious for one of ordinary skill in the art, through routine optimization, to have selected sealing temperatures, therefore conditions, for regions of the margin depending on the desired peel strength in regions of the end product" (Action, page 3, section 4). The Examiner's unexplained conclusion does not satisfy the requirement for a *prima facie* case. *KSR*, 127 S. Ct. at 1741. ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))

In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claims and their meaning, and also fails to present an articulated reason why or how one of skill in the art would arrive at the instant invention, merely given a disclosure of heat sealing. Thus, the claims are erroneously rejected over the Tankersley reference. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of Claim 11 under 35 USC 103(a) as having subject matter unpatentable over U.S. Patent No. 6,957,915 to Tankersley.

Claim 10 is rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Patent No. 6,957,915 to Tankersley in view of U.S. Pat. No. 6,333,087 to Jerdee et al. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the Tankersley reference obviates this rejection. The Jerdee reference adds no new teaching to the Tankersley reference that would result in the inventive package of independent claim 7, and thereby dependent claim 10. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of its dependency from 7, claim 10 is nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,957,915 to Tankersley in view of U.S. Pat. No. 6,333,087 to Jerdee et al.

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03292US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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